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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Bangalore Eshwar Amita RANI et al.
Title: A PROCESS FOR THE PRODUCTION OF EGG YOLK
ANTIBODIES FOR ORGANOCHLORINE PESTICIDES
Appl. No.: 09/973,199
Filing Date: 10/10/2001
Examiner: Phuong N. Huynh
Art Unit: 1644

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to an Office Action mailed November 5, 2002, applicants elect for examination, with traverse, Group III, directed to claims 1-2 and 5-15. Applicants traverse for the following reasons.

The Examiner Has Not Established a Prima Facie Case that Restriction is Proper

Applicants contend for that the Examiner has failed to establish a *prima facie* case under the that the restriction is proper in accordance with the MPEP. As stated in MPEP § 803:

“an application may properly be restricted to one of two or more inventions only if they are able to support separate patents and they are either independent or distinct. If the search of the entire application can be made without serious burden, the examiner **must** examine it on the merits, **even though** it includes claims to independent or distinct inventions.” (MPEP § 803, emphasis added.).
“There are two criteria for a proper requirement for restriction between two patentably distinct inventions: (A) The inventions must be independent or distinct

as claimed; **and** (B) There must be a serious burden on the examiner if restriction is required.” (*Id.*, emphasis added, citations omitted.)

Applicants urge that the Examiner has not offered sufficient evidence to demonstrate either parts (A) or (B), that searching for the claimed process is a serious burden. By the Examiner’s own words, restriction is appropriate because the present inventions are “not capable of use together **and** have different modes of operation, different functions or different effect.” (Emphasis added). The Examiner has not presented any reason as to why different why the different organochlorines are not capable of being used together. Therefore, this argument cannot stand. Furthermore applicants contend that the argument that organochlorines are different in operation, function or effect is also flawed. The invention is not directed to making synthesizing organochlorines and therefore the Examiner is restricting the claims by process steps that are not even recited in the claims.

The Examiner has Admitted the Classification for All Claims is Identical

The Examiner has admitted that all groups can be searched within the same classes and subclasses: 530/389.8. As all of the claims recite a method of producing antibodies by immunizing poultry with organochlorines, the search classification for all groups is the same and the Examiner has failed to present factual evidence of a proper restriction. Applicants respectfully contend that the examiner has not demonstrated “a serious burden.” Therefore applicants request reconsideration and withdraw of the present restriction requirement.

The Restriction Requirement Violates Applicants’ Statutory Right to Examination of an Invention Within a Single Claim

The statutory right for applicants to have their invention examined is clearly supported by case law. The PTO’s reviewing court has long-recognized “an applicant’s right to define what he regards as his invention as he chooses, so long as his definition is distinct, as required by the second paragraph of § 112, and supported by enabling disclosure, as required by the first paragraph of § 112.” *In re Harnisch*, 206 USPQ, 300, 305 (CCPA 1980), *citing In re*

Wakefield, 164 USPQ 636 (CCPA 1970). *See also In re Borkowski*, 164 USPQ 642 (CCPA 1970).

In *Weber, supra*, the CCPA elaborated on this statutory interpretation, stating that restriction within a single claim deprives applicants of their statutory rights.

An applicant is given, by the statute, the right to claim his invention with the limitations he regards as necessary to circumscribe that invention, with the proviso that the application comply with the requirements of §112. We have decided in the past that §112, second paragraph, which says in part "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention," allows the inventor to claim the invention as he contemplates it.

As a general proposition, an applicant has a right to have each claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. *If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits.* The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification.

198 USPQ at 331 (emphasis added; citation omitted).

In his *Weber* concurrence, Judge Rich rejected the premise that a Markush claim could be found improper solely because the claim embraced a plurality of inventions:

Careful review of all statements by the examiner and the board makes it clear beyond question that the only basis asserted for rejecting claims 1-6 is that they cover or embrace or are directed to a plurality of independent and distinct inventions, and this is the sole reason given for saying they are "improper Markush claims" or for saying there is "misjoinder [of inventions] under 35 USC 121." Section 121 is asserted as the only legal basis for this rejection.

The practice here challenged is tantamount to a refusal by the PTO to examine a single Markush claim in a single application because, in its opinion, it is broad enough to "embrace" or "cover" a plurality of inventions which, if presented separately, would be separately patentable, assuming any one of them to be prior art. The label it attaches to such a broad claim is "improper Markush" and the situation is described as "misjoinder."

The fault in the PTO position is that it overlooks the obvious fact that almost any reasonably broad claim "embraces" or "covers" a multiplicity of inventions, in the sense of "dominating" them, which inventions might be separately patentable if and when presented in separate applications. Logically, this is not a sufficient excuse for refusing to examine a claim on its merits for compliance with 35 USC 101, 102, 103, and 112. None of those statutory sections, of course, justifies a refusal to examine.

Id. at 333 (emphasis added).

Finally, *Weber* also stated that applicants' statutory rights take priority over administrative expediencies of the PTO, such as the difficulty of any searching that may be required:

Even though the statute allows the applicant to claim his invention as he sees fit, it is recognized that the PTO must have some means for controlling such administrative matters as examiner caseloads and the amount of searching done per filing fee. But, in drawing priorities between the Commissioner as administrator and the applicant as beneficiary of his statutory rights, we conclude that the statutory rights are paramount.

Id. at 332.

Accordingly, applicants respectfully urge the withdrawal of the restriction requirement and examination of Groups I-III.

Respectfully submitted,

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By 

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